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### Remarks

This paper and the following remarks are fully responsive to the Office Action mailed April 19, 2004.

Original claims 1-4 were cancelled in a preliminary amendment filed December 21, 2001, and then reintroduced still numbered as claims 1-4 in an amendment filed January 28, 2004. Because no statements were made by the Examiner regarding the numbering of these reintroduced claims, the Applicant assumes that the numbering is considered to be acceptable by the Examiner. Claims 5-24 were added in a preliminary amendment filed December 21, 2001.

Claims 11, 16 and 23 have been rejected. The Examiner has allowed claims 1-10, 12-15, 17-22 and 24. The Applicant respectfully acknowledges the allowance of these claims.

None of the claims have been amended or cancelled and no claims have been added in this paper. After entry of this paper, claims 1-24 are pending.

### Claim Rejections – 35 USC § 102(e)

The Examiner has rejected claims 11, 16 and 23 under 35 USC § 102(e) as being anticipated by U.S. Pat. No. 5,588,171 to Sohn, et al. (Sohn). The Examiner states that Sohn reports the limitations of claims 11, 16 and 23 including a visual indicator device. The Examiner further states that the visual indicator limitation is not entitled to the benefit of an earlier filing date before the June 26, 1997 filing date of Sohn, but invites the Applicant to identify the precise location where the visual indicator is reported prior to the filing date of Sohn.

The Applicant respectfully traverses the rejection.

The present patent application claims priority to U.S. Pat. No. 5,972,000 to Beyer et al. (Beyer). The filing date of Beyer, which was previously acknowledged by the Examiner, is October 18, 1996. This filing date pre-dates the June 26, 1997, filing date of Sohn.

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At col. 6, lines 18-19, Beyer reports that the screw is disconnected once the screw is implanted into the bone surface and further reports at col. 6, lines 41-44, that the design of the inserter is such that rotational movement is cancelled upon release. Additionally, at col. 9, lines 65-67 continuing to col. 10, lines 1-2, Beyer reports that as the screw (which is connected to the suture that protrudes from the patient's body) is rotated by the inserter, it enters the bone until it reaches a prescribed depth within the bone at which time the screw automatically disconnects from the rotating inserter shaft. This is an alternative expression of the report made at the last two lines of page 32 continuing for the first three lines of page 33 of the present application, stating that total insertion of the screw is indicated by a cessation of twisting of the protruding suture. Once the fully implanted screw disconnects from the rotating inserter, there is no longer any rotational movement imparted to the screw or movement of the protruding suture attached to the screw. The user of the device could aptly determine from this lack of movement of the suture that full insertion of the screw into the bone has occurred. Thus, Beyer reports the visual indicator element claimed in claims 11, 16 and 23 prior to the filing date of Sohn. Accordingly, claims 11, 16 and 23 are not anticipated by Sohn and are in condition for allowance. The Applicant respectfully requests that the Examiner withdraw the rejection and allow claims 11, 16 and 23.

Furthermore, the Examiner has allowed independent claims 5, 13 and 18 upon which claims 11, 16 and 23 depend, respectively. As set forth in 35 USC § 112, ¶4, "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Thus, claim 11 includes all the elements of claim 5 as well as a visual indicator. Claim 16 likewise includes all the elements of claim 13 and observing a visual indicator. And, claim 23 includes all the elements of claim 18 in addition to a visual indicator. Because claims 11, 16 and 23 each contain all of the elements of the allowable independent claims upon which they depend as well as a further limitation and because Sohn doesn't report all of these elements, they are also in condition for allowance. If the Examiner maintains that claims 11,

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16 and 23 are not allowable, however, the Applicant respectfully requests clarification of the rejection. If the Examiner determines that claims 11, 16 and 23 are in condition for allowance, the Applicant respectfully requests that the Examiner withdraw the rejection and allow claims 11, 16 and 23.

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**Conclusion**

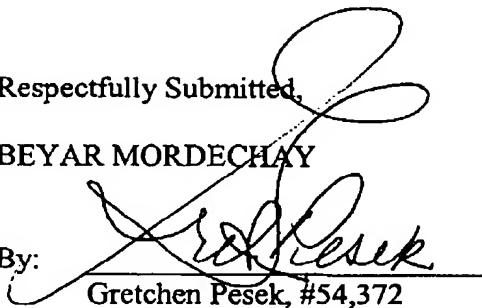
All pending claims are in condition for allowance. A notice to that effect is respectfully requested.

If there are any remaining questions, the Examiner is requested to contact the undersigned at the number listed below.

Respectfully Submitted,

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